

## **REMARKS**

Applicant is in receipt of the Office Action mailed September 5, 2003. A new Declaration with corrected Provisional Application number has been prepared, and is included herewith. The Specification has been amended to address the cited issues, as well as to correct the inventor list to include middle initials. Claim 25 has been amended to correct the cited antecedent basis error. Claims 1-44 remain pending in the case. Further consideration of the present case is respectfully requested in light of the following remarks.

### **Section 102 Rejections**

Claims 1-4, 11-18, 20-25, 30-33, 37-40, and 44 were rejected under 35 U.S.C. 102(e) as being anticipated by McDonald et al. "McDonald", USP 5,966,532.

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 recites:

1. A method for programmatically generating a second graphical program based on a first graphical program, the method comprising:

receiving information specifying the first graphical program;  
programmatically generating the second graphical program based on the information, wherein the second graphical program implements functionality of the first graphical program.

Regarding claims 1, 30, and 38, the Office Action asserts that McDonald teaches a method for programmatically generating a second graphical program based on a first graphical program comprising receiving information specifying the first graphical program, citing col. 4, lines 11-12, programmatically generating the second graphical

program based on the information and the second graphical program implements functionality of the first graphical program, citing col. 4, lines 3-9.

Applicant respectfully disagrees. Column 4, lines 11-12 of McDonald recites:

“...the user first selects a control which represents input to or output from a graphical program.”

Column 4, lines 3-9 recites:

“The graphical programming system executing on the computer system also includes a plurality of front panel objects or controls which represent or indicate input to or output from a graphical program, or represent devices in the graphical program. At least a subset of the controls, e.g., a first plurality of the controls, each include one or more associated graphical code portions or templates.”

Column 4, lines 43-45 recites:

“...the wizard displays on the screen a configuration panel or dialog, prompting the user to configure the control or object.”

As McDonald also states in column 4, lines 54-56:

“The graphical code generation wizard selects a graphical code portion in response to the control, wherein the selected graphical code portion corresponds to the control.”

Finally, in column 5, lines 8-12. McDonald states:

“...the graphical code generation wizard operates to copy the configured graphical code portion or template into the block diagram window where the graphical program is being created.”

Thus, McDonald teaches selection and configuration of controls, and graphical code portions or templates based on the user input are then programmatically included in or copied to a graphical program or block diagram. In other words, the graphical program or graphical program portion is generated or assembled from selected pre-existing controls and graphical code portions or templates, and is specifically not a second graphical program generated based on received information specifying a first graphical program. Thus Applicant respectfully submits that McDonald neither teaches nor suggests all of the features of claims 1, 30, and 38, and so, for at least the reasons

given above, Applicant submits that claims 1, 30, and 38, and claims respectively dependent thereon, are patentably distinct over McDonald.

### **Section 103 Rejections**

Claims 5-10, 26-29, 34-36, and 41-43 were rejected under 35 U.S.C. 103(a) as being unpatentable over McDonald and Sojoodi et al (“Sojoodi”, USP 6,437,805).

As held by the U.S. Court of Appeals for the Federal Circuit in *Ecolchem Inc. v. Southern California Edison Co.*, an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis.

In addition, the showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular . . . . Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

Sojoodi teaches creation of a graphical program via inclusion of an object node in the graphical program in response to user input, where the graphical program is then operable to access capabilities of an object via the object node (Abstract). Thus, Sojoodi neither teaches nor suggests the limitations of claim 1 (or claims 30 and 38). Nor does Sojoodi in combination with McDonald teach or suggest these limitations, and so Sojoodi fails to correct the deficiencies of McDonald. Applicant thus respectfully suggests that since claims 5-10, 26-29; 34-36; and 41-43 are respectively dependent from independent claims 1, 30, and 38, which were shown above to be patentably distinct over McDonald, claims 5-10, 26-29; 34-36; and 41-43 are patentably distinct over McDonald and Sojoodi, for at least the reasons given above.

Claim 19 was rejected under 35 U.S.C. 103(a) as being unpatentable over McDonald and Kadtke et al ("Kadtke", USP 6,401,057). Applicant respectfully disagrees.

The Examiner has merely pointed out that Kadtke implemented a prototype simulating the operation of an analog circuit device using the Simulink package. Nowhere does Kadtke (or McDonald) teach or suggest combining the Simulink package with the system of McDonald to produce Applicant's invention. Applicant submits that even if the Kadtke's use of the Simulink package is combined with the system of McDonald, the combination would not produce all of the features of independent claims 1, 30, and 38, and so Kadtke fails to overcome the deficiencies of McDonald. Thus, Applicant respectfully suggests that since claim 19 is dependent from independent claim 1, which was shown above to be patentably distinct over McDonald, claim 19 is patentably distinct over McDonald and Kadtke, for at least the reasons given above.

## CONCLUSION

In this response, the Specification, including the inventor list, priority claim, and abstract, and claim 25 have been amended. Rejection of claims 1-4, 11-18, 20-25, 30-33, 37-40, and 44 under 35 U.S.C. 102(e) and rejection of claims 5-10, 19, 26-29, 34-36, and 41-43 under 35 U.S.C. § 103(a) have been responded to. This response, therefore, constitutes a complete response to all issues raised in the Office Action mailed September 5, 2003. In view of the remarks traversing the rejections presented in the Office Action, pending claims 1-44 are in condition for allowance. If the Examiner has any questions, comments, or suggestions, the undersigned attorney earnestly requests a telephone conference.

Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5150-48000/JCH.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☒ Replacement Declaration and Power of Attorney
- ☒ Notice of Change of Address

Respectfully submitted,



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